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Dana Andrew Alden
MacLean-Fogg Company
1000 Allanson Road
Mundelein, IL 60060

Applicant: Theodore Bydalek et al
Serial No.: 10/712611
Filed: November 13, 2003
For: FASTENER ASSEMBLY

:DECISION ON PETITION
:UNDER 37 CFR 1.181
:PETITION TO INVOKE
:SUPERVISORY AUTHORITY

This is a decision on the Petition filed July 17, 2007, a Request to Invoke Supervisory Authority to review the Examiner's requirement that replacement sheet of figure 30 was necessary, and to review the Examiner's objection that the replacement sheet for figure 30 constitutes new matter.

The application was filed November 13, 2003, with a Request for Continued Examination (RCE) filed June 14, 2003. In the RCE, applicant included amendments to the claims, which, among other amendments, included language in at least new claim 53 claiming "an annular bearing surface that is provided on the body and generally spherically convex". A non-final rejection was mailed out August 31, 2006, including an objection to the drawings with the statement "the annular bearing surface on the body is spherically convex" must be shown or the feature(s) cancelled from the claim(s), according to rule 37 CFR 1.83 (a). A drawing amendment to figure 30 was submitted on February 28, 2007. In the final rejection of May 17, 2007, the Examiner objected to the added material in figure 30 as not being supported by the specification, such that the added material is new matter.

As to the review of the requirement that the claimed subject matter be in the figures, 37 CFR 1.83(a), as set forth in the Office action dated August 31, 2006, requires the drawings to show every feature of the invention specified in the claims to be illustrated in the drawings. Applicant's options to satisfy this requirement are either to correct the drawings to include the claimed limitation in the drawings, or remove the claimed limitation from the claim(s). Therefore, as set forth in 37 CFR 1.83 (a), if applicant wished to retain the limitation in the claim (s), he or she is required to submit corrected drawings showing the claimed features.

As to issue of new matter, applicants state the specification fully supports amended figure 30 (petition, last paragraph pg 4), and that there are no other locations suitable to be an annular bearing surface (petition, last two paragraphs of page 5). Although the specification states that an annular bearing surface on the body is spherically convex, it clearly does not specify which

surface of the body it is describing. Indeed, in applicant's statement of the facts, he states that the annular bearing surface could be spherically shaped in addition to being frustoconical in shape (petition, page 2, lines 10-12). Since the frustoconical shaped surface is the portion of the body located inside the cap, it would appear that applicants are stating the annular bearing surface is the surface of the body inside the cap. In addition, the portion of the body that is actually a "bearing" surface in figure 30 is the surface on which the lower portion of the cap rests, or the surface facing upward rather than downward in the figure. When only the body and the cap are claimed without the bolt as in claim 53, the lowermost surface of the body has nothing to bear against, making it an unlikely candidate for being a bearing surface. Therefore, the addition of a spherically convex surface to the lowermost surface of the body in figure 30 is new matter, in the event that there are several surfaces that could have been spherically convex, and the exact nature (depth, proportion) of the convex portion were not previously defined.

The requirement for illustration was appropriate, and the objection relating to new matter was appropriate. As to applicant's contention that the examiner placed applicants in an impossible situation (petition, page 4, lines 20, 21), applicant has several possible courses of action, including removing the limitation from the claim (s), amending the limitation to include that which is fully described and illustrated, or filing a continuation-in-part to incorporate the claimed subject matter fully into the specification and figures.

In view of the Notice of Appeal filed August 17, 2007, the Appeal Brief is due October 17, 2007.

SUMMARY: Petition is DENIED.



Donald Hajec
Director, TC 3600
(571) 272-5150

